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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/868,866      | 06/21/2001  | Michael Heckmeier    | MERK 2268           | 6435             |

23599 7590 12/04/2002

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EXAMINER

WU, SHEAN CHIU

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1756

4

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/868,866

Applicant(s)

HECKMEIER ET AL.

Examiner

Shean C Wu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-11 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3</u> . | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Claim 10 provides for the use of the liquid crystalline medium, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. Claim 6 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims on the alternative only and cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5, 7-9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rieger et al. (US 5,368,772 or 5,868,962).

The reference discloses a liquid crystal medium based on a mixture of polar compounds of positive dielectric anisotropy, which is suitable for electrooptical display devices (col. 3, lines 22-45). The reference contains the present compounds of formulae Ia and II (see Examples 20-21). The reference anticipates the claimed invention.

5. Claims 1-5, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Rieger et al. (US 5,328,642 or WO 91/19772).

The reference discloses a liquid crystal medium based on a mixture of polar compounds of positive dielectric anisotropy, which is suitable for electrooptical display devices (col. 3, lines 34-57). The reference contains the present compounds of formulae I and II-VI (see Examples 1-14 and the claims). The reference anticipates the claimed invention.

6. Claims 1-5, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Poetsch et al. (US 5,723,682 or DE 19707154).

The reference discloses a liquid crystal medium containing a difluorovinyl ether derivative with a mixture of polar compounds of positive dielectric anisotropy, which is suitable for electrooptical display devices (col. 1, line 59 to col. 2, line 12). The reference

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contains the present compound of formula I and other compounds are shown in the reference Tables A and B. Also, see Examples A-G. The reference anticipates the claimed invention.

7. Claims 1-5, 7, 9 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bartmann et al. (US 5,643,495 or DE 4308028).

The reference discloses a liquid crystal medium containing a 1,2,2,2-tetrafluoroethyl ether derivative with a mixture of polar compounds of positive dielectric anisotropy, which is suitable for electrooptical display devices (col. 2, lines 54). The reference Example C on col. 48 anticipates the claimed invention.

8. Claims 1, 4 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Reiffenrath et al. (US 5,209,868 or WO 90/12073).

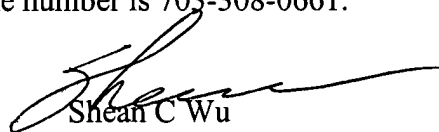
The reference discloses a liquid crystal medium containing trifluoromethylcyclohexane derivatives represented by formula I, which are suitable for electrooptical display devices (col. 2, lines 50-60). The reference Examples B and C on col. 25 anticipate the claimed invention.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shean C Wu whose telephone number is 703-308-3956. The examiner can normally be reached on Monday-Friday 9:30 -6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 703-308-2464. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7718 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Shean C Wu  
Primary Examiner  
Art Unit 1756

SCW

November 27, 2002